

Application No.: 10/674999

Case No.: 58227US002

REMARKS

Claims 1-5 and 8-26 are pending in the Application.

35 U.S.C. §112 Rejections

Claims 18 and 25 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Office Action states:

- In Claim 18 (line 2), "or less" causes confusion because it does not exclude the amount of "0", and Claim 16 requires the presence of the additive.
- In Claim 25 (line 2), "or less" causes confusion because it does not exclude the amount of "0", and Claim 23 requires the presence of the additive.

Applicants respectfully disagree. 35 U.S.C. §112, second paragraph, states "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Courts have not read this paragraph to require a minimum limit in specifications. See *In re Kirsch*, 498 F.2d 1389, 1394 (CCPA 1974), *Cummins Engine Co. v. General Motors Corp.*, 299 F. Supp. 59, 71-72 (D. MD. 1969).

In *In re Kirsch*, the court reversed a 35 U.S.C. § 112 indefiniteness rejection of a claim that required the amount of unrelated olefin in the reaction mixture be maintained at less than seven mole percent. 498 F.2d at 1393-94. The present Applicants' claims 18 and 25 are similar to the claim in *In re Kirsch*, and are therefore definite for the same reasons. Support for the use of additives is found on pages 19-20 of the specification.

In addition, Applicants have previously amended claims 18 and 25 to comply with the earlier rejection for indefiniteness in the Office Action dated December 30, 2005. That Office Action rejected claims 18 and 25 under 35 U.S.C. §112, as being indefinite because explicitly including "0" in the claimed range for the additive caused confusion when independent claims 16 and 23 required the additive to be present. Applicants amended claims 18 and 25 by removing "0", thereby removing any confusion. Claims 18 and 25 must be read in their entirety in order to be interpreted, including reading all the limitations in the claims from which they depend. Independent claims 16 and 23 clearly state that the additive is present. Claims 18 and 25 then

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place an upper limit on the amount of additive that is present (e.g., "present in an amount of 50 percent or less" in claim 18). The only reasonable reading of such language is that (1) the additive is present, and (2) the amount of the additive has the stated upper limit. No reasonable interpretation of the claims could conclude that the stated range includes "0", meaning that the additive is not present. Applicants' previous amendment only underscores this point.

Applicants respectfully request reconsideration and withdrawal of the rejection of claims 18 and 25 under 35 U.S.C. §112, second paragraph.

35 U.S.C. §103 Rejections

Claims 1-5, 9-19, 22 and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,586,104 (Matsuda) in view of U.S. 5,789,476 (Iryo). Applicants disagree.

The substance of this rejection has already been addressed in Applicants' response dated March 30, 2006, and Applicants incorporate those arguments herein. In response to Applicants' arguments, the Examiner has merely observed that Matsuda discloses polymers having a molecular weight range that overlaps with the polymers disclosed by Applicant, and that Matsuda discloses that the solid content of the composition can be varied depending on the application. From this the Examiner states that there is a reasonable basis to believe that, "within this range of solid content, Matsuda's composition should possess a suitable viscosity for the intended specific application set forth in the instant claims, absent evidence to the contrary."

The Examiner cannot satisfy his evidentiary burden by simply speculating that there should be a composition somewhere within a range disclosed by a reference that would meet the requirements of a particular application. This holds particularly true under the present circumstances where the reference does not teach or suggest the claimed application (digital printing), and when the subject art area is unpredictable.

Applicants continue to maintain that any combination of Matsuda and Iryo, if proper, does not disclose all the elements of Applicants' claims. Further, the Examiner's reliance on speculation in an unpredictable art and for an application unappreciated by the cited references underscores the fact that one of skill in the art could not reasonably expect success. Therefore, a prima facie case of obviousness has not been made, and Applicants request reconsideration and withdrawal of the rejection of claims 1-5, 9-19, 22 and 26 over Matsuda in view of Iryo.

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Claims 20 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuda in view of U.S. 6,251,486 (Chandross). Applicants disagree.

Chandross adds nothing to cure the deficiencies of the Matsuda reference. As such, Applicants submit that any combination of Matsuda and Chandross, if proper, does not disclose all the elements of Applicants' claims, and therefore that a prima facie case of obviousness has not been made. Applicants request reconsideration and withdrawal of the rejection of claims 20 and 21 over Matsuda in view of Chandross.

Claims 1-5, 8, 10-15, 18, 19 and 22-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuda in view of U.S. 4,909,852 (Atkinson). Applicants disagree.

Atkinson adds nothing to cure the deficiencies of the Matsuda reference. As such, Applicants submit that any combination of Matsuda and Atkinson, if proper, does not disclose all the elements of Applicants' claims, and therefore that a prima facie case of obviousness has not been made. Applicants request reconsideration and withdrawal of the rejection of claims 1-5, 8, 10-15, 18, 19 and 22-26 over Matsuda in view of Atkinson.

Claims 16-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuda in view of U.S. 4,173,490 (Rotenberg). Applicants disagree.

Rotenberg adds nothing to cure the deficiencies of the Matsuda reference. As such, Applicants submit that any combination of Matsuda and Rotenberg, if proper, does not disclose all the elements of Applicants' claims, and therefore that a prima facie case of obviousness has not been made. Applicants request reconsideration and withdrawal of the rejection of claims 16-18 over Matsuda in view of Rotenberg.

Applicants submit that claims 1-5 and 8-26 are in condition for allowance, and request early indication of the same.

Respectfully submitted,

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Date

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